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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,602	11/27/2000	Frances H. Arnold	9373/1G811US1	5781

7590

07/03/2002

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EXAMINER

PAK, YONG D

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 07/03/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,602

Applicant(s)

ARNOLD ET AL.

Examiner

Yong Pak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 63-111 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 111 is/are allowed.
- 6) ☒ Claim(s) 63-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The amendment filed on April 15, 2002, amending claims 63-111, has been entered.

Claims 1-18 and 63-111 are pending.

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action. Rejections and/or objections not reiterated from previous Office action are hereby withdrawn.

Response to Arguments

Applicant's arguments filed April 15, 2002 have been fully considered but they are not persuasive.

Election/Restrictions

Applicant's election without traverse of Group III (claims 63-82) in Paper No. 10 is acknowledged.

Claims 1-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

Notice of Possible Rejoinder: The Examiner notes that if claim 19 is found directed to an allowable product, then claims 1-18, which are directed to the process of

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using the patentable product previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also MPEP 821.04, *In re Ochiai*, and *In re Brouwer*). Since process claims 1-19 would be rejoined and fully examined for patentability under 37 CFR 1.104, applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 63-110 remains rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants argue that the claimed invention is defined both by structural and function features. The examiner disagrees. The claims are drawn to a genus of polynucleotides encoding mutant galactose oxidases, from any source and with any structure. Therefore, many structurally unrelated polypeptides are encompassed within the scope of these claims. Also, there is no evidence on the record of the relationship

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between the structure of a *D. dendroides* galactose oxidase and the structure of a galactose oxidase from another source. The specification fails to describe any other representative species by any identifying characteristics or properties other than the "functionality" of having galactose oxidase activity and fails to provide any structure: function correlation present in all members of the claimed genus.

Claims 63-110 remains rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the mutant galactose oxidase from *D. dendroides*, does not reasonably provide enablement for mutant galactose oxidase of unknown structure. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants argue that one of ordinary skill in the art can make and use the claimed invention according to the guidance in the specification without undue experimentation because the polypeptides are evolved from a parent nucleotide, the *D. dendroides* galactose oxidase gene. The examiner disagrees. The mutant oxidases encompassed in these claims are not necessarily evolved from a galactose oxidase of *D. dendroides* but from any source comprising of mutation corresponding to the various amino acid residues of SEQ ID NO:10 and 18.

Despite knowledge in the art for the isolation of amino acids, the specification fails to provide guidance regarding how to isolate other galactose oxidase whose

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sequence is not homologous to the galactose oxidase from *D. dendroides*. Therefore, the breadth of these claims is much larger than the scope enable by the specification.

The predictability as to the level of conservation between the disclosed sequences and those of other galactose oxidase is extremely complex. While recombinant techniques are available, it is not routine in the art to screen large numbers of amino acids where the expectation of obtaining similar sequences is unpredictable. The amino acid sequence determines the structural and functional properties of an enzyme. Knowledge of which sequences can be altered or removed and still result in similar protein activity is well outside the realm of routine experimentation.

Allowable Subject Matter

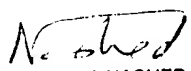
Claim 111 is allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 703-308-9363. The examiner can normally be reached on 8:00 A.M. to 4:30 P.M weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Yong Pak
Patent Examiner


NASHAAT T. NASHED PHD.
PRIMARY EXAMINER

July 1, 2002